

Remarks:

Reconsideration of the present application is respectfully requested. In the Office Action, the examiner rejected claims 1, 5, 6, 11, and 12 as being anticipated by U.S. Patent No. 5,297,796 issued to Peterson. Claims 2-4 were rejected as being unpatentable over Peterson in view of U.S. Patent No. 2,805,071 issued to Kaplan. Claims 7-10, 13-16, and 17-20 were rejected as unpatentable over Peterson in view of U.S. Patent No. 3,936,055 issued to Scott.

New claims 21-38 have been presented which Applicant respectfully suggests are novel and nonobvious considering the references cited.

Claim set 21-30 have been crafted to highlight one important difference between the present invention and Peterson. That difference is that the golfer is able to make a normal swing on the device of the present invention. This is because the user is able to stand on an upper surface which is part of the device which is substantially coplanar with said simulated activity playing surface. Peterson, in contrast, forces the golfer to swing unnaturally because his or her feet are located substantially below the plane in which its simulated playing surface exists.

Claims 31-34 are designed to highlight the fact that the suitcase design of the present invention has been made easily portable. Thus, these claims have been made to include limitations that the device has a first portion connected to a second portion. The first portion supports the display. The second portion includes the upper surface upon which a user may stand while swinging. This arrangement is not shown in any of the references.

Remaining claims 35-38 have been directed to a method incorporating these same important distinctions from the references cited.

The examiner, in the office action, combined Peterson with Kaplan, and then Peterson with Scott. The Applicant believes that the examiner has failed to meet its burden here.

Missing from the last office action is any evidence showing motivation to combine Berent with Hagmann. It is fundamental to a finding of obviousness, that the rejection be based on evidence in the record. *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). To support such a rejection, the Examiner must reveal evidence showing that there is a teaching, motivation, or suggestion to select and combine the references relied on. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). This factual inquiry must be thorough. *Id.* Additionally, it must be based on objective evidence in the record. *See Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) (“a showing of a suggestion, teaching, or motivation to combine the prior art references is an `essential component of an obviousness holding'”) (quoting *C.R. Bard, Inc., v. M3 Systems, Inc.*, 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembicza*k, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998). The showing must be specific. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (“particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed”); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (even when the level of skill in the art is high, there must be the identification of a specific principle, known to one of ordinary skill, that suggests the claimed combination). Instead of presenting objective evidence from the record, the examiner has based the rejections of conclusory statements. These do not suffice, legally speaking.

The application is believed to be in condition for allowance. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action.

Respectfully submitted,



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